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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,483	09/19/2003	Marcia L. Stockton	RSW920030194US1	8859

7590 12/13/2006

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EXAMINER

CAPUTO, LISA M

ART UNIT PAPER NUMBER

2876

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/666,483	<b>Applicant(s)</b> STOCKTON, MARCIA L.	
	<b>Examiner</b> Lisa M. Caputo	<b>Art Unit</b> 2876	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-14 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-14 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>506, 906, 1106</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Amendment***

1. Receipt is acknowledged of the amendment and response to election/restriction filed 28 September 2006.

### ***Information Disclosure Statement***

2. The name of the patentees for reference numbers U.S. Patent No. 6,193,162 and U.S. Patent No. 6,327,578 on the IDS filed 22 May 2006 were incorrect. These references will be cited on the Notice of References Cited form 892 so that they are properly cited.

### ***Double Patenting***

3. Claims 1-10, 12-14, and 22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 9, and 12 of U.S. Patent No. 7,012,528 to Mathewson, II et al. (from hereinafter "Mathewson").

Although the conflicting claims are not identical, they are not patentably distinct from each other because in claims 1-10, 12-14, and 22 of the instant application, applicants claim a system and method for preparing information usable in theft detection using RFID technology comprising the steps of reading a customer identifier from a customer loyalty card, and during the current transaction, storing the customer identifier in an item-identifying RFID tag affixed to each of at least one items being paid for by a shopper in the current transaction, such that the item-identifying RFID tag affixed to each of the at least one items possessed by the shopper can subsequently be searched to determine whether the at least one possessed items were paid for in the current

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transaction. The Mathewson patent teaches a method of detecting potential theft using RFID technology comprising reading from a transaction receipt a correlator value and searching, in an RFID tag affixed to each of one or more items possessed by the shopper who also possess the transaction receipt, for the correlator value, and concluding that at least some of the items possessed by the shopper were not paid for if the correlator value is not located in the searching step. Although the scope of claims 1-10, 12-14, and 22 of the instant application and claims 1-4, 9, and 12 of the Mathewson patent are very similar, the difference between the present claimed invention and the Mathewson patent is that the instant application utilizes a loyalty card with a customer identifier for a current transaction, wherein the Mathewson patent utilizes a transaction receipt with a correlator value for a previous transaction as means for identifying a customer. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teaching of the Mathewson patent as a general teaching to arrive at the instant invention because the same steps of identifying a customer, and searching RFID tags affixed to items are being performed, and it would have been obvious to use a customer identifier on a loyalty card as opposed to a correlator value on a receipt since both scenarios provide a form of identifying the user in order to accomplish the goal of determining if an item has been properly paid for in a transaction, whether previous or current.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

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from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

### ***Allowable Subject Matter***

4. Claims 1-10, 12-14, and 22 would be allowable upon the timely filing of a terminal disclaimer.

The following is a statement of reasons for the indication of allowable subject matter: The best prior art of record fails to specifically teach that a customer identifier is read from a customer loyalty card, and then further storing that customer identifier in an item-identifying RFID tag that is affixed to items and is searchable to determine if the items were paid for by the shopper.

### ***Conclusion***

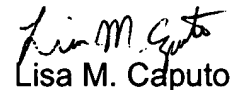
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Lisa M. Caputo** whose telephone number is **(571) 272-2388**. The examiner can normally be reached between the hours of 8:30AM to 5:00PM Monday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached at **(571) 272-2398**. The fax phone number for this Group is (571) 273-8300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [[lisa.caputo@uspto.gov](mailto:lisa.caputo@uspto.gov)].

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*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Lisa M. Caputo

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December 10, 2006